



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,908	12/10/2003	Mauro Cristofari	FR920020008US1	5797
25299	7590	05/31/2006	EXAMINER	
IBM CORPORATION PO BOX 12195 DEPT YXSA, BLDG 002 RESEARCH TRIANGLE PARK, NC 27709			BOTTS, MICHAEL K	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 05/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/731,908	Applicant(s) CRISTOFARI ET AL.	
	Examiner Michael K. Botts	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This document is the first Office Action on the merits. This action is responsive to the following communications: The Non-Provisional Application, which was filed on December 10, 2003.
2. Claims 1-11 have been examined, with claims 1, 8, and 10 being the independent claims.
3. Claims 1-11 are rejected.

The Specification

4. Applicant is required to update the status (pending, allowed, etc.) of all parent priority applications in the first line of the specification. The status of all citations of U.S. filed applications in the specification should also be updated where appropriate.
5. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claims Rejections – 35 U.S.C. 112, Second Paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 2176

6. Dependent claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 25 U.S.C. 112, second paragraph. See, *Ex Parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990). See also, MPEP 2173.05(p).

Claim 8 is an improper hybrid claim in that it claims a computer program, yet depends from the method of claim 1.

7. In the interest of compact prosecution, the application is further examined against the prior art, as stated below, upon the assumption that the applicants may overcome the above stated rejection under 35 U.S.C. 112, second paragraph.

Claims Rejections – 35 U.S.C. 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Dependent claim 8 is rejected under 35 U.S.C. 101 because the claimed inventions are directed to non-statutory subject matter. As noted below, claim 8 is directed to neither a “process” nor a “manufacture,” but rather embrace and overlap two different statutory classes of invention set forth in 35 U.S.C. 101, which is drafted so as

to set for the statutory classes of invention in the alternative only. See, Ex Parte Lyell, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990). See also, MPEP 2173.05(p).

Claim 8 is an improper hybrid claim in that it claims a computer program product (manufacture), yet depends from the method of claim 1.

9. In the interest of compact prosecution, the application is further examined against the prior art, as stated below, upon the assumption that the applicants may overcome the above stated rejections under 35 U.S.C. 101.

Claims Rejection – 35 U.S.C. 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 1-5 and 7-11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ingram, et al. (U.S. Patent 6,925,496 B1, filed June 16, 2000) [hereinafter "Ingram"].

Regarding **independent claim 1**, Ingram teaches:

In a data processing apparatus (105) executing a hypertext-document browsing software application, a method of managing requests to print a selected hypertext electronic document comprising:

a) creating an output electronic document and incorporating therein an information content of the selected hypertext electronic document; and

(See, Ingram, claim 13, teaching displaying a first page containing a hyperlink.)

b) automatically inspecting the selected hypertext electronic document for detecting hypertext links included therein, each hypertext link linking a respective linked hypertext electronic document to the selected hypertext electronic document;

(See, Ingram, claim 13, teaching detecting a cursor in proximity to the hyperlink and displaying a toolbar adapted to display the linked page.)

further comprising, for each hypertext link detected in the selected hypertext electronic document:

c) automatically accessing the respective linked hypertext document;

d) extracting from the linked hypertext document an indication of an information content thereof;

e) providing the user with said indication of the information content of the linked hypertext electronic document;

f) conditioned by a selection of the user, including at least said indication of the information content of the linked hypertext electronic document into the output electronic document.

(See, Ingram, claim 13, teaching detecting a cursor in proximity to the hyperlink and displaying a toolbar adapted to display the linked page.

Ingram does not expressly teach automatically accessing the linked document, but Ingram does teach an automatic response to the proximity of the cursor to the hyperlink. Automatic accessing a linked page would have been obvious to one of ordinary skill in the art for the obvious and beneficial purpose of automating the selection process for convenience or speed of access.)

Regarding **dependent claim 2**, Ingram teaches:

The method according to claim 1, in which act f) comprises including at least said indication of the information content of the linked hypertext electronic document at a position within the output electronic document corresponding to a position of the respective hypertext link in the selected hypertext electronic document.

(See, Ingram, claim 13, teaching detecting a cursor in proximity to the hyperlink and displaying a toolbar adapted to display the linked page.)

Regarding **dependent claim 3**, Ingram teaches:

The method according to claim 1 in which act f) further comprises, for each hypertext link enabling the user to chose (i) not to include, (ii) to include only said indication of the information content or (iii) to include the full information content of the respective linked hypertext document.

(See, Ingram, claim 13, teaching detecting a cursor in proximity to the hyperlink and displaying a toolbar adapted to display the linked page.

Ingram implicitly teaches the user options in the toolbar, which permits the user to select the linked document, to display an icon, or to not select.)

Regarding **dependent claim 4**, Ingram teaches:

*The method according to claim 1 further comprising:
iterating the acts b) to f) on each linked hypertext electronic document,
until a predefined level of iteration is reached.*

(See, Ingram, claim 13, teaching that the individual hyperlinks are individually selectable, and therefore the acts of selecting will be iterated.)

Regarding **dependent claim 5**, Ingram teaches:

*The method according to claim 4, further comprising:
enabling the user defining said level of iteration.*

Art Unit: 2176

(See, Ingram, claim 13, teaching that the user determines the level of selection with each iteration.)

Regarding **dependent claim 7**, Ingram teaches:

The method claim 1, further including sending the output electronic document to a printer for printing onto a material support, or storing the output electronic document on a storage device.

(See, Ingram, col. 4, lines 65-67, teaching to save the document.)

Regarding **independent claim 8**, Ingram teaches:

A computer program directly loadable into a memory of a data processing apparatus, for actuating the method according to any one of the preceding claims when the program is executed.

(Claim 8 incorporates substantially similar subject matter as claimed in claim 1 and is rejected along the same rationale.)

Regarding **dependent claim 9**, Ingram teaches:

A computer program product comprising a computer readable medium on which the computer program of claim 8 is stored.

(Claim 9 incorporates substantially similar subject matter as claimed in claim 1 and is rejected along the same rationale.)

Regarding **independent claim 10**, Ingram teaches:

A hypertext-document browsing software application, comprising:

means for locating and accessing selected hypertext electronic documents according to respective addresses;

and means for managing requests of printing of the selected hypertext electronic documents, characterized in that said means for managing print requests includes;

means for automatically inspecting a selected hypertext electronic document to be printed for detecting hypertext links, each hypertext link linking a respective linked hypertext electronic document to the selected hypertext electronic document;

means for automatically accessing the hypertext documents corresponding to the detected hypertext links, without having the user personally activating the corresponding hypertext link;

means for providing the user with an indication of an information content of each of the linked hypertext electronic documents, and for enabling the user defining whether or not the linked document is to be printed, and

means for creating an output electronic document containing an information content of the selected hypertext electronic document and, conditioned by a selection made by the user, at least said indication of the information content of the respective linked hypertext electronic document.

(Claim 10 incorporates substantially similar subject matter as claimed in claim 1 and is rejected along the same rationale.)

Regarding **dependent claim 11**, Ingram teaches:

A data processing system supporting the exchange of hypertext electronic documents, comprising at least one computer programmed to execute the hypertext document browsing software application of claim 8.

(Claim 11 incorporates substantially similar subject matter as claimed in claim 1 and is rejected along the same rationale.)

11. **Claim 6** is rejected under 35 U.S.C. 103(a) as being unpatentable over Ingram as applied to claim 1 above, and further in view of Coats (U.S. Patent 6,282,545 B1, filed October 28, 1993) [hereinafter "Coats"].

Regarding **dependent claim 6**, Ingram teaches:

The method according to claim 1 in which said acts e) and f) include:
generating a tree-like diagram of the linked hypertext electronic documents, said tree-like diagram including a tree node for each linked hypertext electronic document;
displaying to the user the tree-like diagram, associated with each tree node the indication of the information content of the respective linked hypertext electronic document, and enabling the user to define, for each tree node,

whether or not at least the indication of the information content of the respective linked hypertext document is to be included in the output electronic document.

(Ingram teaches display of hyperlinked documents as icons, but does not expressly teach the display of such icons in a tree-like diagram.

Coats teaches the "hypertree" as a structure to display nodes as links to data.

Ingram and Coats are combinable in that they both involve the art of the display of hyperlinks to data.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Ingram and Coats.

The suggestion or motivation for the combination of the references is found in Coats, stating: "It is therefore an object of the present invention to provide a system which extracts information from software and a variety of other sources and provides a mechanism for traversing and filtering this information." See, Coats, col. 2, lines 11-14. Ingram provides the identification and access to the hyperlink data, but not the display mechanism for traversing the information, which is provided by Coats according to Coats' object.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine Ingram and Coats to create an invention of the specifications of claim 6.)

12. It is noted that any citations to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to

Art Unit: 2176

be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art.

See, MPEP 2123.

Conclusion

13. The following prior art is made of record and not relied upon that is considered pertinent to applicants' disclosure:

Gropper, et al. (U.S. Patent 7,000,186 B1).

Nielsen (U.S. Patent 6,199,071 B1).

Kraft (U.S. Patent 5,870,767).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael K. Botts whose telephone number is 571-272-5533. The examiner can normally be reached on Monday through Friday 8:00-4:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

Art Unit: 2176

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MKB/mkb

A handwritten signature in black ink, appearing to read "Doug Hutton", with a stylized flourish at the end.

**DOUG HUTTON
PRIMARY EXAMINER
TECH CENTER 2100**